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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				
EXAMINER				
FEATHERSTONE, MARK D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,450

Applicant(s)

TECOT ET AL.

Examiner

MARK D. FEATHERSTONE

Art Unit

4157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 3/19/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of indefinite claim language. The claim recites "that the creation of another mark if that other mark occurs 'approximately at the same time' as the first-mentioned mark". The amount of time should be specified either as an absolute number, or "less than" a specific number.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

3. Claims 1-2, 5-8, 10-15, 16-20, 24-31, and 33 are rejected under 35

U.S.C. 102(e) as being anticipated by Vallone et al, US Patent # 6642939.

With regard to Claim 1, Vallone discloses:

A method for presenting information comprising:

adding a mark, that is associated with the information, at a source location by activating a marking mechanism (column 16, lines 34-40 – Vallone teaches here a bookmark feature, where the user can mark his place on a program, and come back later to begin watching at the same place); and presenting the information at a destination location based on the mark added at the source location (column 16, lines 49-50 – Vallone teaches that the viewer can “continue watching from the bookmark”), wherein at least one of said adding the mark and said presenting the information involves displaying a visual indicator of the mark at a display position that is related to a time at which the mark was associated with the information (column 21, line 11-18 – Vallone describes a “trick play bar” in which the bookmarks are indexed along the timeline of the program, and there are marks that are “labeled uniquely” to indicate to the user a bookmark at that position).

Claim 2 is the method of claim 1 with the specification of the source location the same as the destination location. This feature is inherent in the Vallone disclosure described above.

Claim 5 and 6 are the method of claim 1, wherein the information comprises a media content program and video media content program. Vallone's disclosure deals with bookmarking a video media program (column 16, lines 34-36).

With regard to claim 7, Vallone discloses:

The method according to claim 1, wherein the marking mechanism comprises a mark button provided on a remote control which interacts with a processing mechanism that implements said adding of the mark (Fig. 14, item 1406 and column 16, lines 57-58 – Vallone describes a remote control button to invoke the mark).

With regard to claim 8, Vallone discloses:

The method according to claim 1, further including deleting the mark by selecting the visual indicator of the mark and activating the marking mechanism again (Column 16, lines 52-54)

With regard to Claim 10, Vallone discloses:

The method according to claim 1, wherein the visual indicator of the mark has visual display properties that convey at least one characteristic of the mark (column 21, lines 11-15 – Vallone's visual display "uniquely gives the user a visual cue that an index or bookmark exists at that position")

With regard to Claim 11, Vallone discloses:

The method according to Claim 10, wherein the visual display properties include at least one color for presenting the visual indicator (column 21, lines 11-15)

With regard to Claim 12, Vallone discloses:

The method according to claim 10, wherein said at least one characteristic of the mark pertains to an identity of a user who added the mark (column 17, lines 1-14 - Vallone describes the process of which the user is identified by remote control, and the bookmarks displayed pertain to that specific user)

Claim 13 is rejected based on the claim 8 rejection. It is inherent that the act of selecting a bookmark gives the user the indication of whether the bookmark is selected or not.

Claims 14-15 are rejected based on the claim 10 rejection. As stated, the user would be aware of the identity of the user based on the displayed bookmark.

With regard to Claim 16, Vallone discloses:

The method according to claim 1, wherein the displaying involves presenting the visual indicator of the mark at a display position along a timeline, where the position conveys a juncture at which the mark occurs within the information (Column 21, lines 11-15 - Vallone describes a "trick-play" bar, where bookmarks are displayed based on their position in a "sequential" timeline.

Claim 17 is rejected based on the claim 16 and claim 10 rejections. As stated, Vallone teaches that the bookmarks are displayed over a timeline, with multiple indicators of position and user.

With regard to Claim 18, Vallone discloses:

The method of Claim 17, further including navigating among the multiple visual indicators to select any one of the visual indicators (column 21, lines 15-18 - Vallone describes the ability to "sequentially jump" between bookmarks.

Claim 19 is rejected based on Claim 18 rejection. In column 21, lines 15-18, Vallone further teaches the use of a button a remote control to navigate between index points.

Claim 20 is rejected based on Claim 18 and Claim 7 rejection.

With regard to Claim 24, Vallone discloses:

The method according to claim 1, wherein the presenting is invoked upon another activation of the marking mechanism (column 16, lines 49-58 – Vallone describes using the remote control to invoke the bookmarks)

Claim 25 is rejected based on the claim 1 and 18 rejections (As stated, Vallone describes a "trick play" bar, which would correspond to a menu, and a method to invoke the bookmarks from the trick play bar.

Claim 26 is a computer readable medium containing instructions to implement the method of Claim 1, and is therefore rejected.

Claim 27 is not distinct from claim 1, and is rejected. As in claim 1, it involves invoking a marking mechanism, displaying the marks, and adding a mark.

Claim 28 is rejected based on the claim 1, 12, and 13 rejection (Vallone teaches several different indications associated with a bookmark, including based on time, and based on user).

Claim 29 is the computer readable medium to implement the features of claim 27 and is rejected.

Claim 30-31 is the system to implement the method of claims 1-2, and is rejected on this basis.

Claim 33 is the system to implement the method of claim 27, and is rejected on this basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

5. **Claims 3-4 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Vallone et al” in view of “Schindler et al, US Patent # 5675390”.**

With regard to claims 3-4, and 32, Vallone discloses the method of claim 1 and 30 as stated, however he fails to teach the feature of a different physical location of the source and destination. Schindler, in his patent, discloses a home network to “transmit data and control within the home” (column 21, lines 30-32).

Given these two references, a person of ordinary skill in the art would have found it obvious to combine the system of Vallone, with the networking capability of Schindler, in order to access the features of the system from various

locations within the home, with the advantage of increased flexibility in viewing locations.

6. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Vallone et al” in view of “Russon, US PG Pub # 20040001107”.

With regard to claims 21-23, Vallone teaches the method of claim 1, but fails to teach the generation of a thumbnail image associated with the bookmark, with the thumbnails displayed in chronological order. Russon, in his application, discloses the method of generating and organizing thumbnail images chronologically (paragraph 0016).

Given these two references, a person of ordinary skill in the art would have found it obvious to combine the booking display system of Vallone, with the ability to display the bookmarks as thumbnails in chronological order, as Russon teaches for the purpose of alternatively identifying information associated with a bookmark.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over “Vallone et al” in view of “Lu et al, US Patent # 6647548”.

With regard to Claim 9, Vallone teaches the method of claim 1, but fails to teach the feature of precluding the creation of another mark if that other mark occurs approximately at the same time as the first mark. LU, in his patent, teaches a method of preventing a record being captured by a “very fast channel

change" (column 13, lines 1-9). This would result from the user pushing the channel change button at a fast rate (which is programmable).

Given these two references, a person of ordinary skill in the art would have found it obvious to combine these two references in order to combine the bookmark generating capabilities of Vallone's system with the error checking capabilities of Lu's system in order to prevent unintended records (bookmarks) from being recorded.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose telephone number is 571-270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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